

FILE COPY

Office - Supreme Court, U. S.

FILED

JAN 16 1947

**CHARLES ELMORE CROPLEY
CLERK**

In the Supreme Court of the United States

OCTOBER TERM, 1946.

No. 792.

THE GENERAL METALS POWDER COMPANY,

Petitioner,

vs.

THE S. K. WELLMAN COMPANY and S. K. WELLMAN,

Respondents.

**PETITIONER'S REPLY BRIEF ON ITS
PETITION FOR CERTIORARI.**

F. O. RICHEY,

B. D. WATTS,

Counsel for Petitioner.

RICHEY AND WATTS,

1150 Union Commerce Bldg.,

Cleveland 14, Ohio,

Of Counsel.



INDEX.

I. The claims were held invalid on the sole reason of "lack of invention".....	1
II. Definition of Invention.....	4
III. Conflict and Confusion Below.....	5

Cases Cited.

<i>Foxboro v. Taylor</i> , 157 Fed. (2) 226 (C. C. A. 2).....	5
<i>Grant Paper Box Co. v. Russell Box Company</i> , 154 Fed. (2) 729 (C. C. A. 1).....	5



In the Supreme Court of the United States

OCTOBER TERM, 1946.

No. 792.

THE GENERAL METALS POWDER COMPANY,

Petitioner,

vs.

THE S. K. WELLMAN COMPANY and S. K. WELLMAN,

Respondents.

PETITIONER'S REPLY BRIEF ON ITS PETITION FOR CERTIORARI.

Now comes Petitioner and prays leave to file the following brief as a reply to the Respondents' Brief:

I.

The claims were held invalid on the sole reason of "lack of invention." The new combination recited in the claims includes two sub-combinations called the (1) "metal network" or "metallic network" and the (2) "composition."

The Courts found that each of these sub-combinations was old in the prior art, but did not find that both had ever been included in the same method or same structure. The finding of lack of novelty was, therefore, based upon, and could only mean that these separate sub-combinations were found to be old in different constructions or methods.

Thus Finding of Fact 6 (II, p. 789) relates only to the "metal network." It was not, therefore, the entire combination which the District Court found that the plaintiff had been in error in its representations to the Patent Office, but only this "metal network" or one feature of the combination claims.

In Finding of Fact 7 the Court found that the "metal network" was present in certain prior art patents, but did not find that the entire combination, including the "composition," was present in any of these prior art patents.

In Finding of Fact 8 the same finding was made. That finding is also limited to the "network," as was the comment regarding the demonstrations of the experts in *inter partes* tests. The Court did not find that the entire combination of any of the claims was either in any one of these prior art devices or was demonstrated by the testimony of these experts.

In Finding of Fact 9 the Court found that the other sub-combination, i.e., the "composition" was old in certain prior art, but did not anywhere find that the entire combination was old.

These findings of the presence of certain elements of the combinations in some prior art devices and the presence of some other elements of the combinations in some other prior art devices are made throughout and supported by the proof. There is no finding that the entire combination of any of the claims is found in any prior art device or method and no proof to support any such conclusion. This, of course, explains the finding of "novelty." If the Court had found any of the entire combinations present in the prior art, the finding would have been one of "anticipation." The finding of lack of novelty is, therefore, nothing but the finding of non-invention where different features found in the combination claims are taken from different prior art disclosures and combined by means of hindsight to form a new combination of elements or steps which perform the "amazing results" which the defendant attempts to dissipate by characterizing them as a "gratuitous observation in the opinion." These are very positive statements in the opinion, which are supported by the undisputed testimony in the record. It is also supported by the defendant's own pronouncements.

Specimens of these proclamations are:

(R. Vol. III, 363):

"It can't be burned out. You can ride it all day and you won't hurt it. It wears like a pig's nose.

* * * * *

"Think of the market for it among the fleets and trucks where they overload the jobs and then wonder why ordinary facings give out.

* * * * *

"It is non-competitive, there isn't another one on the market."

(R. Vol. III, 364):

"the molded lining that has never yet been known to score a brake drum. The lining which cures noisy brakes and brings you satisfied repeat business.

* * * * *

"the lining which wears and wears and wears."

(R. Vol. III, 365):

"You CAN'T BURN THEM OUT. They wear like a pig's nose. For those jobs where the Driver 'Rides the Clutch' or holds the car on grades without a brake, These Facings are the Answer.

"Trucks * * * Where they Overload 'em; Passenger Cars * * * Where they Ride 'em; Automatic Clutches * * * Where they Slip 'em; They're all alike to VELVETOUCH METALLIC FACINGS. You want to know about them, The More Than Modern Facings.

"Every Maintenance Man and Fleet Operator that's seen Them Wants Them * * * They're That Kind of Item."

See also R. Vol. III, 369.

These pronouncements made to the world by defendant relate to the defendant's doings found to infringe by the Court below. They support the pronouncements of the District Judge in his opinion to which we have referred. These

statements in the opinion of the District Judge supported by this evidence pronounced by the defendant would be more reliable than any Findings of Fact to the contrary, if there were any such Findings of Fact to the contrary since, as is well known, the prevailing counsel participates in the preparation of the Findings of Fact, if he does not, in fact, write them. But supported by defendant's pronouncements and uncontradicted by a finding the opinion must prevail.

II.

Definition of Invention. Counsel suggest that we have not suggested a definition for invention. This also is incorrect. We have suggested that there be adopted the definition suggested by President Roosevelt's Patent Planning Commission headed by Mr. Kettering (see p. 8 of our Petition and Brief) and which, as is well recognized, was the definition followed for something like one hundred years in the administration of the patent law and is the one referred to by the First Circuit Court of Appeals as the old, or traditional, test (see p. 16 of our Petition and Brief). We need no legislation and need have no misgivings about returning to this test. It was followed for something like one hundred years by the patent Courts in this country under the present patent statutes and has, as those Courts said, proved to be eminently satisfactory as shown by the tremendous progress made in science, invention, mechanics, etc., to the benefit of all during the years when that test was employed and that definition adhered to.

The instant cause presents a perfect case for its application. Here we have new combinations of old elements or steps which achieve "amazing results," which greatly benefited the public and which were widely adopted because of their merits and because they supplied a long standing want and need. They also solved problems which baffled the industry and those skilled in the industry over a long

period of time. (All of these things were found by the District Court and recited in the Court's opinion, see page 18 of our Brief on our Petition.) Where these facts existed the Courts applying the objective test found the presence of new combinations of old elements or steps sufficient even though the change was slight. Under this test the Courts were persuaded by the achievement and the benefit conferred upon the public and gave little weight to the character of the change. Indeed, modest changes in structure or method were held to support the presence of invention and not defeat it.

III.

Conflict and Confusion Below. That there does exist confusion in the Courts of Appeals regarding the Sinclair decision is clear from not only the conflict which we pointed out in our brief, but from the fact that the First Circuit Court of Appeals gave different interpretations to the Sinclair decision on the main hearing and on the rehearing in the *Grant Paper* case, and, further, by Judge Hand's comments made in the *Foxboro* case since the Sinclair decision was handed down (see pp. 25 and 26 of our Petition and Brief.)

That each of these cases was not, and cannot be, treated upon its own particular facts is manifest from the fact that the First Circuit Court of Appeals came to such different interpretations of the Sinclair decision that upon the same set of facts it first found the patent invalid and then found it valid. The confusion to which Judge Hand refers and under which he is left to divine what he thinks this Court would do is also predicated upon a definite set of facts. Where the old, or traditional, or objective test was applied, the Courts were able, and did within reasonable limits, apply the rule to any and every set of facts. There were many sets of facts, such as were stated by the District Court to appear in this cause, and which do appear in this

cause, under which the finding of invention under this old test was clear. There were again other sets of facts under which non-invention was to be found under the objective test rule formerly applied. That there may have been some twilight zone sets of facts where the question was in dispute is immaterial. The most that could be said was that sometimes the application of the rule was in doubt. However, the twilight zone cases were few, whereas, as we have pointed out, under existing conditions there is confusion with respect to almost every case, as appears from the decisions which we have cited and discussed in our Petition and Brief.

Thus, not only is a definition of invention possible, but an eminently satisfactory definition of invention was adopted and followed for something like one hundred years and its reinstitution was recommended by the Kettering Patent Commission. All we are asking this Court to do is to adopt that recommendation, reinstate the definition which was so satisfactory and under which so much progress was made, and direct its application to the instant cause where the District Judge said that as a conscientious Judge he "regretted" that he could not apply it because of present conditions as he understood them, and was unable to do so without a change in the basic law (II, p. 787) whereas there would need to be no change in the basic law because under the currently existing law this definition was adopted and followed for something like one hundred years by this and other Courts.

Respectfully submitted,

F. O. RICHEY,

B. D. WATTS,

Counsel for Petitioner.

RICHEY & WATTS,

1150 Union Commerce Bldg.,

Cleveland 14, Ohio,

Of Counsel.